

**REMARKS**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter "command". This objection is overcome in view of the amendments to claims 17 and 24.

Claims 17-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Stanesti et al.** [hereinafter Stanesti][20040160213] and **Smart Battery System Specifications** @ <http://www.sbsforum.org/specs/sbsel100.pdf>. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed by applicant **Shyr et al.** [hereinafter Shyr][5903764] and **Smart Battery System Specifications** @ <http://www.sbsforum.org/specs/sbsel100.pdf>. These rejections are traversed in view of the amendments to claims 17 and 24.

Independent claims 17 and 24 include: ... the charge and discharge switches being closed in response to the electronics device and the controller being in agreement to charge one of the smart batteries, and either of the charge or the discharge switches being opened in response to one of the electronics device and the controller directing either of the charge and discharge switches to be opened; and...

35 U.S.C. §103(a) provides that:

*[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the **Stanesti et al.** and **Shyr et al.** patents do not teach ... the charge and discharge switches being closed in response to the electronics device and the controller being in agreement to charge one of the smart batteries, and either of the charge or the discharge switches being opened in response to one of the electronics device and the controller directing either of the charge and discharge switches to be opened; and...

Therefore, it is impossible to render the subject matter of claim as a whole obvious based on the **Stanesti et al.** and **Shyr et al.** patents considered, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 17 and 24, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the **Stanesti et al.** and **Shyr et al.** patents cannot be applied to reject claims 17 and 24 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

*[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*

Here, neither **Stanesti et al.** nor **Shyr et al.** do not teach or even suggest ... the charge and discharge switches being closed in response to the electronics device and the controller being in agreement to charge one of the smart batteries, and either of the charge or the discharge switches being opened in response to one of the electronics device and the controller directing either of the charge and discharge switches to be opened; and...

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 17 and 24.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention

PATENT

Docket No.: 16356.803 (DC-04938)

Customer No.: 000027683

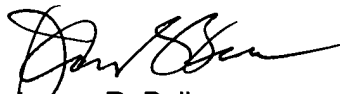
without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 17 and 24. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 17 and 24, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 17 and 24 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 17-24 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



James R. Bell

Registration No. 26,528

Dated: 3-6-06  
HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 512/867-8407  
Facsimile: 214/200-0853  
ipdocketing@haynesboone.com

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
on	<u>Mar 6, 2006</u>
Date	<u>Susan C. Lien</u>
	Susan C. Lien